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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,020	10/03/2005	Sanjay Suri	04-40419-US	9391

7590 02/07/2008  
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EXAMINER

YOUNG, SHAWQUIA

ART UNIT PAPER NUMBER

1626

MAIL DATE DELIVERY MODE

02/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/520,020	<b>Applicant(s)</b> SURI ET AL.	
	<b>Examiner</b> Shawquia Young	<b>Art Unit</b> 1626	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 November 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,7-10,12-16,18-20 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3 and 7 is/are allowed.
- 6) ☒ Claim(s) 8-10, 12-16, 18-20 and 22-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

Claims 1-1, 3, 7-10, 12-16, 18-20 and 22-26 are currently pending in the instant application. Applicants have cancelled claims 2, 4-6, 11, 17 and 21 and added new claims 23-26 in an amendment filed on November 20, 2007.

### **I. *Response to Arguments***

Applicant's amendments, filed November 20, 2007, have overcome the following rejection(s) and/or objection(s): the rejection of claims 1-22 under 35 USC 112, first paragraph as failing to enablement requirement; the rejection of claims 5 and 6 under 35 USC 103 as being obvious over WO 97/03958; the rejection of claims 1 and 8-22 under 35 USC 112, second paragraph as being indefinite; the objections of claims 2, 11-17 and 20-22 as being in improper form; and the objection of claims 1, 3, 7 and 20 for informalities. The above rejections and objections have been withdrawn.

### **II. *Rejection(s)***

#### ***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-10, 12-16, 18-20 and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the process in

claims 8 and 9 contain the limitation in the last step "drying to get required water of crystallization" but it is unclear what is meant by the above limitation. Applicants have deleted the term "hydrates" in the instant claims so what "required water" is being referred to in the above claims.

Claims 8, 10, 12, 14-16, 19, 20 and 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 8, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 8, 10, 12, 14-16, 19, 20 and 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the term "dematerialized water" in step (c) on claim 8, is not defined in the disclosure to know what the term means. It is unclear what Applicants are referring to when using the term "dematerialized water".

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the term "comprising" is considered open-ended and it is unclear what organic solvents are embraced by the claim.

Claims 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Specifically, the above claims state the limitation, for example, "the organic solvent used is 100 times of the starting compound". It is unclear what is being compared in the claims, whether Applicants are referring to molar ratio, weight, etc.

Claim 14-16 recites the limitation "the starting compound" which is dependent on claims 8 or 9 but the term "starting compound" is not found in claims 8 or 9. There is insufficient antecedent basis for this limitation in the claim.

### **III. *Objections***

#### *Claim Objections*

Claim 10 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed and shall not serve as basis for any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim 10 has not been further treated on the merits.

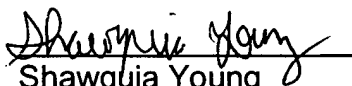
Claim 20 and 22-24 are objected to because of the following informalities: claims 20 and 22-24 contain the term "effected" or "effect" but these terms does not make sense in the context that they are being used and are grammatical errors. Claim 23 is missing the term "or" between vacuum tray drier and rotacon vacuum drier. Appropriate correction is required.

#### **IV. Conclusion**

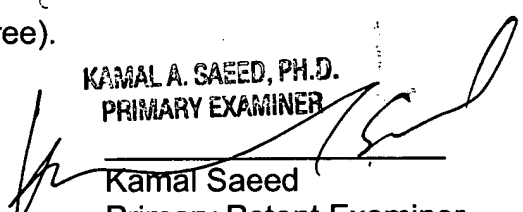
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawquia Young whose telephone number is 571-272-9043. The examiner can normally be reached on 6:30 AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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